

REMARKS

Claims 1-32 were originally filed in the present application. Claims 1, 3-8, 13, 17, 19-24, and 29 are currently amended. No claims are currently canceled or added. Accordingly, claims 1-32 are currently pending in the present application.

Reconsideration of the present application is respectfully requested in light of the foregoing amendments and the following remarks.

Rejections under 35 U.S.C. §103

Claim 1

Claims 1-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,667,751 to Wynn et al. ("Wynn") in view of U.S. Patent Application Publication No. 2005/0278629 to Chailleux ("Chailleux"). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1 and, therefore, with respect to claims 2-16 which depend from claim 1.

As the PTO recognizes in MPEP §2142:

... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness....

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness with respect to claim 1 for at least the following reasons.

The Reference Does Not Teach the Claimed Subject Matter

As provided in 35 U.S.C. §103:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that

the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, in the context of claim 1, Wynn fails to teach or suggest enabling searching of data associated with the screen shots. To the contrary, Wynn merely teaches a “thumbnail history page viewer” which enables a user to view a series of bitmap images (Wynn, column 8, lines 66-67; column 9, lines 1-43). A person of ordinary skill in the art would recognize that viewing a series of bitmap screen shots does not teach or suggest enabling searching of data associated with the screen shots as recited in the context of claim 1.

Moreover, Chailleux fails to cure the shortcomings of Wynn. That is, Chailleux also fails to teach or suggest enabling searching of data associated with the screen shots. Examiner alleges that Chailleux paragraphs [0070]-[0071] disclose enabling searching and viewing of the screen shots within a screen shot file, however the cited paragraphs merely teach storing screen shots to a hard disk, and viewing the stored screen shots. Nowhere in the cited paragraphs does Chailleux teach or even suggest enabling searching of data associated with the screen shots. Similar to Wynn, Chailleux merely teaches a “main view” and a “list view” (Chailleux, paragraph [0071], Figs 6-7), which allow a user to view a series of bitmap images. Much in the same manner described above with regard to Wynn, a person of ordinary skill in the art would recognize that Chailleux fails to teach or suggest enabling searching of data associated with the screen shots as recited in the context of claim 1. Thus, Chailleux also fails to teach or suggest enabling searching of data associated with the screen shots.

Because Wynn and Chailleux each independently fail to teach or suggest searching of data associated with the screen shots, the combination of Wynn and Chailleux necessarily fails to teach or suggest each and every limitation of claim 1.

Thus, the Examiner has not met the burden of factually supporting a *prima case* of obviousness, and the Applicants respectfully request the Examiner to withdraw the §103 rejection with regard to claim 1 and its dependent claims.

Claim 17

Claims 17-32 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Wynn in view of Chailleux. As described above, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, much in the same manner as described above with regard to claim 1, Wynn in view of Chailleux fail to teach or suggest a means to enable searching of data associated with the screen shots. Accordingly the §103 rejection of claim 17 and its dependent claims is not supported by Wynn in view of Chailleux. Therefore, Applicants respectfully request that the Examiner withdraw the §103 rejection of claim 17 and its dependent claims.

CONCLUSION

All matters set forth in the Office Action have been addressed. It is clear from all of the foregoing that independent claims 1 and 17 are in condition for allowance. Dependent claims 2-16 and 18-32 depend from and further limit independent claims 1 and 17 and, therefore, are allowable as well. Accordingly, it is believed that all claims are in condition for allowance.

An early formal notice of allowance of claims 1-32 is requested. Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



Dave R. Hofman

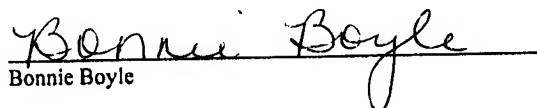
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